

REMARKS/ARGUMENTS

The Office Action mailed December 29, 2005, has been received and reviewed. Claims 1 through 10 are currently pending in the application. Claims 1 through 10 stand rejected. Applicant respectfully requests reconsideration of the application.

35 U.S.C. § 103(a) Obviousness Rejections

Obviousness Rejection Based on U.S. Patent No. 6,387,473 to Sismondi et al.

Claims 1 through 10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sismondi et al. (U.S. Patent No. 6,387,473). Applicant respectfully traverses this rejection, as hereinafter set forth.

M.P.E.P. 706.02(j) sets forth the standard for a Section 103(a) rejection:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations.** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). (Emphasis added).

Sismondi is relied upon as teaching an ink jet receiving sheet comprising a support and ink receiving layers on the support. The ink receiving layer is said to comprise glossiness improving agents, matting agents, a plasticizer, biocides and conventional additives. However, Sismondi does not teach or suggest that the ink-receiving layer "consist[s] of at least one hydrophilic polymer, at least one cross-linking agent, at least one mordant, inorganic particles, at least one nonionic siloxane copolymer surfactant, and at least one nonsiloxane surfactant," as required by independent claims 1, 6, and 8. Rather, Sismondi discloses that its ink receptive layer includes all of the aforementioned elements. However, claim 1 recites the transitional phrase "consisting of" and, therefore, ingredients not specified in claim 1 are excluded.

The Office Action acknowledges that Sismondi does not disclose the use of siloxane containing surfactant as the non-ionic surfactant. To overcome this deficiency, the Examiner relies on Li to show that a non-ionic surfactant by the tradename Silwet is "equivalent" to

non-ionic surfactants by trade names Fluorad and Triton. However, Applicant respectfully disagrees with the Examiner's reading of Li. Specifically, Li discloses use of a surfactant and goes on to state that the "surfactant is considered not to be a part of the film-forming organic polymer" and, thus, is not equivalent of the ink-receiving layer as claimed in the present invention. More significantly, Li states that "there are many available surfactants and combinations of surfactants which may be used. Examples of suitable surfactants include . . . Fluorad FC-170-C surfactant, . . . Triton X-405 surfactant, Silwet L-77 surfactant . . ." (col. 16, line 64 to col. 17, line 4). Thus, a clear reading of this particular section of Li cited by the Examiner expressly recites a list of "suitable" and "available" surfactants that may be used in combination with other elements of a coating composition. However, there is no description, suggestion, or teaching in Li stating that Silwet, Fluorad and Triton surfactants are "equivalent" to each other or that they are to be considered equivalent versions of non-ionic surfactants to a person of skill in the art, as suggested in the Office Action.

Claims 2-5, 7, 9, and 10 depend from independent claims 1, 6, and 8. Dependent claims of non-obvious independent claims are also non-obvious. *See, In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Therefore, Claim 2-5, 7, 9, and 10 are non-obvious and Applicant requests that the 35 U.S.C. § 103(a) rejection thereof be withdrawn.

In view of the foregoing, Applicant respectfully requests withdrawal of the present obviousness rejection and allowance of claims 1-10.

CONCLUSION

Claims 1-10 are believed to be in condition for allowance, and an early notice thereof is respectfully solicited. Should the Examiner determine that additional issues remain which might be resolved by a telephone conference, he is respectfully invited to contact Applicant's undersigned attorney.

Respectfully submitted,



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